

In re Appln. Of: Horst et al.  
Application No.: 10/803,308

34. (Currently amended) The apparatus of claim ~~32~~ 33, wherein the ~~button-like~~ central base member includes one or more torque receiving elements for applying torque to the apparatus, to thereby facilitate threadably screwing the apparatus into the backing of the carpet.

#### REMARKS

Claims 1-34 remain pending in the present application. Claims 2, 4, 7, 8, 10, 12, 15, 16, 18, and 21-29 have been withdrawn from consideration by the Examiner. Claims 1, 3, 5, 6, 9, 11, 13, 14, 17, 19, 20 and 30-34 stand rejected. The claims have been amended herein to obviate informalities and improve their form.

#### CLAIM OBJECTIONS

The claim objections, to claims 1, 20, 30 ~~33~~, and 34, are rendered moot or traversed by the amendments made herein.

Claim 1 has been cancelled, thereby rendering moot the Examiner's objection to the term "button-like."

Claims 30 and 34 have been amended to replace the term "button-like" with the words substantially flat and planar.

Claim 20, the term "anchor tab" has been replaced by the words upper surface of the central base member, as supported by the drawings and specification.

Claim 33 has been amended to replace the limitation "gripping" elements with "grasping" elements, as supported at paragraph 35 of the specification. Claim 33 has also been amended to depend from claim 34, rather than from claim 32, for reasons explained below with regard to amendments made to claim 34, in traversing the Examiner's rejection of claim 34.

Claim 34 has also been amended to be dependent from claim 32, rather than from claim 33. In response to the Examiner's expressed confusion between the "torque receiving elements" of claim 34, and the "grasping [~~gripping~~] elements" of claim 33, the Applicant refers the Examiner to paragraph 35 of the specification.

As disclosed in paragraph 35, the limitation torque-receiving features, or elements, is intended to have a broader scope than the limitation grasping elements, although in a given embodiment of the invention, a feature may be both torque-receiving and graspable. As used with regard to the present invention, torque-receiving elements encompass any feature which can be used, with the assistance of a tool or by hand, to apply torque to the apparatus, for screwing an apparatus according to the invention into the backing of the

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substrate, whereas the term grasping element is intended to encompass only those torque-receiving elements which could be grasped directly by the fingers of a person screwing the apparatus through the backing, or through use of certain "grasping" type tools, such as a pliers, for example.

CLAIM REJECTIONS UNDER 35 USC § 102

**The rejection of claims 1, 3, 5, 6, 9 and 30, as being anticipated by GB 2113993 (GB '993), per paragraph 10 of the Office Action, is traversed.**

Claim 1 has been cancelled herein, thus rendering moot the Examiner's rejection thereof.

Claim 3, as amended herein to independent form, and claims 5, 6 and 9 depending therefrom, all require, *inter alia*, one or more downwardly extending spikes that are adapted to pass through a layer of pile and engage the backing of an underlying substrate. Contrary to the Examiner's assertions in paragraphs 11 and 12 of the Office Action, GB '993 does not disclose any engagement of a backing by one or more downwardly extending spikes extending through the pile and to or through the backing of the pile. In fact, GB '993 expressly discloses only that the spikes 3 "will...bed themselves into the carpet pile." GB '993, page 2, lines 26-27. GB '993 also expressly distinguishes itself over prior art carpet gripping devices which embed themselves into the backing of a carpet from below, GB '993 page 1, lines 19-38, and discloses the undesirability of having a carpet-gripping device engage the backing of a carpet, thereby teaching away from the present invention, *id.* GB '993 does not disclose all limitations of claim 3, or claims 5, 6, and 9 depending from claim 3, and, therefore, cannot anticipate any of claims 3, 5, 6, or 9.

Claims 5, 6, and 9 also include additional limitations which are not disclosed or taught by GB '993, in combination with the limitations discussed above, and therefore, cannot be anticipated by GB '993.

Claim 30 requires, *inter alia*, a single downwardly extending spike that is adapted for penetrating completely through the pile layer and backing of a carpet, having the pile extending upward from the backing, and engaging the lower surface of the backing, to thereby fixedly attach the apparatus to the underlying carpet.

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GB '993 does not disclose the use of a single spike for fixedly attaching and securing a rug to an underlying carpet. GB '993 discloses only a plurality of spikes, not the use of a single spike, as is required by claim 30, and claims 31-34 depending from claim 30, and cannot, therefore, anticipate any of claims 30-34.

GB '993 also does not disclose a spike penetrating completely through a carpet pile and backing and engaging the back side of the backing, as required by claims 30-34, and cannot, therefore, anticipate any of claims 30-34. *See remarks above with reference to the traversal of the rejection of claims 3, 5, 6 and 9 as being anticipated by GB '993.*

With regard to the Examiner's rejections of claims 3, 5, 6, 9 and 30, as being anticipated by GB '993, the Applicant further respectfully submits that the Examiner's inferences that GB '993 is "capable of use" (Office Action, paragraph 11), "capable of penetrating..." and "capable of performing..." (Office Action, paragraph 13), "each spike (3) [of the plurality of spikes 3] is an individual piece, each spike is considered to be a single spike" (Office Action, paragraph 13), are inappropriate extrapolations of the disclosure and teachings of GB '993.

As stated in MPEP § 2112 "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir.1993). Further, "in relying upon inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

It is respectfully submitted that the Office Action fails to provide a basis in fact and/or technical reasoning to reasonably support the Examiner's assertions of the allegedly inherent characteristics cited in paragraphs 11-13 of the Office Action. The Office Action merely makes conclusory statements, apparently based on the Examiner's belief that the above referenced limitations are inherently present in, or could be extrapolated from, the disclosure and teachings of GB '993.

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### CLAIM REJECTIONS UNDER 35 USC § 103

The following quotations from MPEP § 2143 form the primary basis for traversing all rejections in the Office Action, under 35 U.S.C. § 103(a):

#### **2143 Basic Requirements of a Prima Facie Case of Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

#### **2143.01 Suggestion or Motivation To Modify the References [R-1]**

##### **THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION**

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

##### **FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

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**The rejection of claims 11, 13, 14, 17, 19, 20 and 31-34, as being unpatentable over GB '993, in view of Carr (US Patent number 1,731,704) per paragraphs 15-21 of the Office Action, is traversed.**

Applicant first notes that the Examiner has not cited any evidence of motivation within the cited references or the level of knowledge of those skilled in the art to which the invention pertains, for combining the teachings of GB '993 and Carr.

In meeting the requirement for citing evidence of motivation for combining references, the Examiner cannot rely solely on conclusory statements, as presented in paragraphs 15, 17, 19 and 20 4 of the Office Action. Conclusory statements cannot be relied on when dealing with particular combinations of prior art and specific claims. The rationale for combining references must be put forth. *In re Lee*, 61 U.S.P.Q. 2d 1430, 1433. The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that the knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

Only by impermissibly working backward from the Applicant's disclosure can the Examiner allege any grounds for asserting the combination of GB '993 and Carr. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)(The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Applicant further respectfully notes that GB '993 teaches away from the use of a device, such as Carr, which is attached to the floor, and which do not grip the pile of the carpet on which a matt is being secured. See GB '993, page 1, lines 21-44.

Claims 11, 13, 14, 17, 19, 20 and 21, all depend from claim 3, and claims 31-34 depend from claim 30. As stated above, in relation to traversal of the rejection under 35 USC § 102, the Examiner has not, and indeed cannot, provide a proper basis for rejecting any of the pending claims over GB '933, because GB '993 standing alone fails to teach or suggest all of the claim limitations required by independent claims 3 or 30, or any claim depending

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therefrom. The Examiner, correctly, does not assert that Carr standing alone teaches or suggests all of the claimed limitations of claims 11, 13, 14, 17, 19, 20, 21 or 31-34. The Examiner, also correctly, does not assert that Carr teaches or suggests the limitations for which GB '993 was incorrectly cited, as discussed above with regard to traversal of the rejection of the independent claims under 35 USC § 102. The combination of GB '993 and Carr, therefore, also does not teach or suggest all of the limitations of either independent claims 3 or 30, and thus fails to meet the *prima facie* requirements for a case of obviousness for claims 3 or 30 or any of claims 11, 13, 14, 17, 19, 20, 21, or 31-34 depending respectively from claims 3 or 30. *MPEP § 2143. MPEP 2143.03, citing In re Fine, 837 F.2d 1071 (Fed. Cir 1988)(if an independent claim is non obvious under 35 USC 103, then any claim depending therefrom is non-obvious).*

With regard to the Examiner's statements in paragraph 15, of the Office Action, the Applicant is in agreement with the dictionary definition of a "barb," as "a sharp projection extending backward." However, the Applicant notes that the Examiner has provided no basis for his assertion that the outer surface of the thread, in certain embodiments of the present invention, is a "sharp projection that extends backward." Such an interpretation of a thread, as being equivalent to a "barb" would seem to be an extrapolation far beyond a typical dictionary definition of a thread as being "a helical or spiral ridge on a screw, nut, or bolt." (*The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. 06 Sep. 2006. <Dictionary.com <http://dictionary.reference.com/search?q=thread&x=38&y=13>>).

As discussed above, the Examiner cannot simply rely on conclusory statements, as a basis for rejecting claims in the Applicant's patent application. The Applicant, therefore, requests clarification and support of the Examiner's assertion that a thread is somehow equivalent to a barb, so that the Applicant may properly respond to the Examiner's assertions.

In paragraph 16, of the Office Action, the Examiner asserts that "[w]ith respect to claims 13 and 14, Carr discloses the central base member to include an adhesive (5) with a removable protective membrane (8)." After a close reading of Carr, the Applicant has not been able to determine any reference to an adhesive or removable protective membrane in the disclosure and/or teachings of Carr. Specifically, Carr includes an aperture 5, and spaces 8 between edges 9 of the jaws 4.

The Applicant, therefore, requests clarification of the Examiner's comments in paragraph 16.

In paragraph 18, with respect to claims 19 and 20, the Examiner once again asserts that Carr discloses an adhesive 5 and a removable protective membrane 8, and also an

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attachment tab 6, none of which are referenced in Carr. The Applicant, accordingly requests clarification of the Examiner's unsupportable statements in paragraph 18.

#### CONCLUSION

The Applicant believes that the application is in condition for allowance, and for the reasons stated above, also believes that the Examiner has not provided a proper basis for rejection of the pending claims. Reconsideration and notification of allowance are respectfully requested. Given the incomplete nature of the Office Action, the Applicant further believes that, in the event the Examiner should wish to maintain a rejection on the basis of GB '993 and Carr, that any subsequent rejection on the basis of GB '993 and Carr should be non-final.

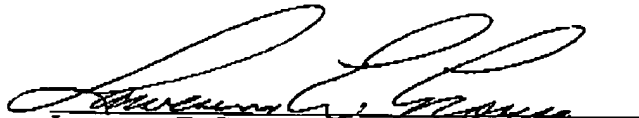
#### EXAMINER TELEPHONE CONFERENCE REQUESTED

If, after reviewing the above amendments and remarks, the Examiner does not believe the claims to be allowable, the Applicant requests that the Examiner contact the undersigned Attorney for the Applicant, prior to issuing either an Advisory Action or another Office Action, to arrange for a telephone conference.

#### PROCEDURAL MATTERS AND FEES

The Applicant hereby requests a one month extension in the shortened time for response, and authorizes the Commissioner to charge deposit account number 50-3505 for the Extension fee. The Applicant believes that no other fees are occasioned by the submittal of this paper. If any fees are occasioned by the filing of this paper, however, the Commissioner is authorized to charge those fees, or credit any overpayments to deposit account 50-3505.

Respectfully submitted,



Lawrence E. Crowe, Reg. No. 35,110  
Reinhart Boerner Van Deuren P.C.  
2215 Perrygreen Way  
Rockford, Illinois 61107  
(815) 633-5300 (telephone)  
(815) 654-5770 (facsimile)

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